



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/863,047	05/23/1997	FUMIAKI ITO	35.C12088	4264

5514 7590 03/12/2002

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

116

# Office Action Summary

Application No.

08/863,047

Applicant(s)

ITO ET AL.

Examiner

Ella Colbert

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8-13 and 15-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 8-13, and 15-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 2172

## **DETAILED ACTION**

### **Response to Amendment**

1. Claims 1, 3, 4, 8-13, and 15-46 are presented for examination. Claims 1, 4, 9, and 11-14 have been amended in this communication filed 12/18/01, entered as Amendment E, paper number 22. Claims 5, 14, and 47-61 have been cancelled in this communication.

### **Claim Rejections - 35 USC § 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 8-13, and 15-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Morita et al (US 5,832,470), hereafter Morita.

With respect to claim 1, Morita teaches a document retaining means for retaining a plurality of folders storing at least one document (col. 2, lines 66-67 and col. 3, lines 1-10), candidate folder selecting means for selecting a plurality of candidate folders suitable for retaining a new document by comparing a feature of the new document with an average of features of the documents stored in a folder ... (col. 3, lines 48-57, col. 6, lines 50-56 and col. 11, lines 1-17), and providing advance notification of the candidate folders ... (col. 12, lines 27-44 and col. 14, lines 50-67). Morita did not explicitly teach,

Art Unit: 2172

wherein the notification is provided in a list form including candidate folders in col. 13, lines 43-52 and col. 14, lines 13-36, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the notification provided in a list form including candidate folders and to modify Morita's system to have the notification provided in a list form including candidate folders because such a modification would enhance Morita's hierarchical document arrangement and classification of placement of documents into folders.

With respect to claim 3, Morita teaches candidate folders suitable for saving the new document are selected and a list of selected candidate folders is displayed (col. 16, lines 29-52).

With respect to claim 4, Morita teaches a judging means for judging a similarity degree between document information and sets of information of documents stored in a folder (col. 13, lines 12-25), similarity order calculating means for calculating a similarity order of a plurality of folders in accordance with the similarity judged by the judging means (col. 13, lines 26-35) and notifying means for providing notification of the similarity order of the plurality of folders calculated by said similarity order calculating means (col. 12, lines 42-67). Morita did not explicitly teach, the notification is provided in a list form including candidate folders, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the notification provided in a list form including candidate folders and to modify Morita's system to have the notification provided in a list form including candidate folders because such a

Art Unit: 2172

modification would enhance Morita's hierarchical structure, classification of placement of documents into folders, and the classified result of the output.

With respect to claim 8, Morita teaches the selecting means selects the folder through statistical estimation using the number of information sets of documents belonging to the folder and the number of documents matching the search condition (col. 11, lines 53-57 and col. 24, lines 36-57).

With respect to claim 9, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 10, this independent claim is rejected for the similar rationale given for claim 4.

With respect to claim 11, Morita teaches retaining a plurality of folders each storing a plurality of sets of document information (col. 2, lines 66-67 and col. 3, lines 1-10); selecting a plurality of folders from among the plurality of folders based on a number of sets of document information containing a keyword inputted as a search condition (col. 3, lines 48-57, col. 6, lines 50-56 and col. 11, lines 1-17); providing notification of the folders selected in the selecting step (col. 12, lines 27-44 and col. 14, lines 50-67). Morita did not explicitly teach, wherein the notification is provided in a list form including candidate folders, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the notification provided in a list form including candidate folders and to modify Morita's system to have the notification provided in a list form including candidate folders because such a

modification would enhance Morita's hierarchical document arrangement and classification of placing documents into folders.

This claim is also rejected for the similar rationale given for claims 1 and 9.

With respect to claim 12, Morita did not teach a computer readable storage medium for storing programs, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a computer readable storage medium for storing programs to perform steps 1-4 and to modify in Morita because such a modification would allow Morita to have a recordable medium (e.g., floppy disks, hard drives, compact disks, or memory cards) and to have the capability to carry out all or some of the steps to perform the method of claim 12.

This independent claim is also rejected for the similar rationale given for claims 1 and 9.

With respect to claim 13, this independent claim is rejected for the similar rationale given for claims 1, 4, 9, and 10.

With respect to claim 15, this dependent claim is rejected for the same rationale given for claim 3.

With respect to claim 16, this dependent claim is rejected for the same rationale given for claims 3 and 15.

With respect to claim 17, Morita teaches updating the feature of the folder in response to saving the new document in the candidate folder (col. 14, lines 5-10).

With respect to claim 18, Morita teaches the document includes vector data (col. 11, lines 20-36).

Art Unit: 2172

With respect to claim 19, the candidate folder has a high-level rank as determined by the result of the comparison (col. 12, lines 45-64).

With respect to claim 20, a notifying means displays a label which is set in advance to indicate the candidate folder (col. 25, lines 19-35).

With respect to claim 21, Morita teaches the document includes text data (col. 25, lines 40-62).

With respect to claim 22, Morita teaches a selected candidate folder (col. 26, lines 10-38). Morita did not explicitly teach, saving the new document, but it is well known in the art by one having ordinary skill in the art to save a new document to a folder because a user can retrieve the saved document from the folder and work on the document when the document is needed.

With respect to claim 23, this dependent claim is rejected for the similar rationale given for claim 17.

With respect to claim 24, this dependent claim is rejected for the similar rationale given for claim 18.

With respect to claim 25, this dependent claim is rejected for the similar rationale given for claim 19.

With respect to claim 26, this dependent claim is rejected for the similar rationale given for claim 20.

With respect to claim 27, this dependent claim is rejected for the similar rationale given for claim 21.

Art Unit: 2172

With respect to claim 28, this dependent claim is rejected for the similar rationale given for claim 22.

With respect to claim 29, this dependent claim is rejected for the similar rationale given for claim 23.

With respect to claim 30, this dependent claim is rejected for the similar rationale given for claims 18 and 24.

With respect to claim 31, this dependent claim is rejected for the similar rationale given for claims 19 and 25.

With respect to claim 32, this dependent claim is rejected for the similar rationale given for claim 20.

With respect to claim 33, this dependent claim is rejected for the similar rationale given for claim 21.

With respect to claim 34, this dependent claim is rejected for the similar rationale given for claims 22 and 28.

With respect to claim 35, Morita teaches a notification only for a predetermined number of folders with a high rank of similarity order (col. 12, lines 42-64).

With respect to claim 36, Morita teaches the document is stored in a folder mentioned in the notification provided (col. 12, lines 65-67 and col. 13, lines 13-19).

With respect to claim 37, this dependent claim is rejected for the similar rationale given for claim 26.

With respect to claim 38, this dependent claim is rejected for the similar rationale given for claim 27.



With respect to claim 39, this dependent claim is rejected for the similar rationale given for claim 35.

With respect to claim 40, Morita teaches the document is stored in at least one folder mentioned in the notification in the notifying step (col. 2, lines 66-67 and col. 3, lines 1-19).

With respect to claim 41, this dependent claim is rejected for the similar rationale given for claims 26 and 37.

With respect to claim 42, this dependent claim is rejected for the similar rationale given for claim 33.

With respect to claim 43, this dependent claim is rejected for the similar rationale given for claims 35 and 39.

With respect to claim 44, this dependent claim is rejected for the similar rationale given for claim 40.

With respect to claim 45, this dependent claim is rejected for the similar rationale given for claim 41.

With respect to claim 46, this dependent claim is rejected for the similar rationale given for claim 33.

#### **Response to Arguments**

4. Applicant's arguments filed 12/18/01 have been fully considered but they are not persuasive.

Applicants' argue: Nothing in Morita would actually teach or suggest providing a notification of the candidate folders to a user, as recited in Claim 1 and Morita cannot,

Art Unit: 2172

and does not, provide the required clear teaching of the feature of, not only providing such notification, but providing it in the form of a list including the candidate folders has been considered but is not persuasive because it is interpreted as Morita teaching providing a notification of the candidate folders to a user in col. 1, lines 30-44 (retrieval conditions (providing a notification to a user) are designated by a user when the user selects the desired information). Morita does not explicitly teach providing the notification in the form of a list including candidate folders, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the notification provided in a list form including candidate folders in view of Morita's teaching of a list and folders to modify Morita's system to have the notification provided in a list form including candidate folders because such a modification would enhance Morita's hierarchical document arrangement and classification of placing documents into folders.

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 2172

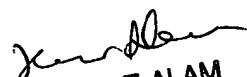
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 for After-Final communications Or (703)746-7239 for Official communications Or (703)746-7240 for Non-Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
E. Colbert  
March 5, 2002

  
HOSAIN T. ALAM  
PRIMARY EXAMINER